

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Mario J. Bravomalo et al.	§	Atty Docket No.: 29471.4
	§	
Application No.: 10/684,023	§	
	§	Examiner: Jayesh A. Patel
Filing Date: October 10, 2003	§	
	§	
Title: System and Method for	§	Art Unit: 2624
Assessment of Health Risks and	§	
Visualization of Weight Loss and Muscle	§	
Gain	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT

Dear Sir:

Applicant hereby timely responds to the Notice of Allowance dated January 20, 2010, in the above referenced application.

Remarks begin on page 2 of this paper.

REMARKS

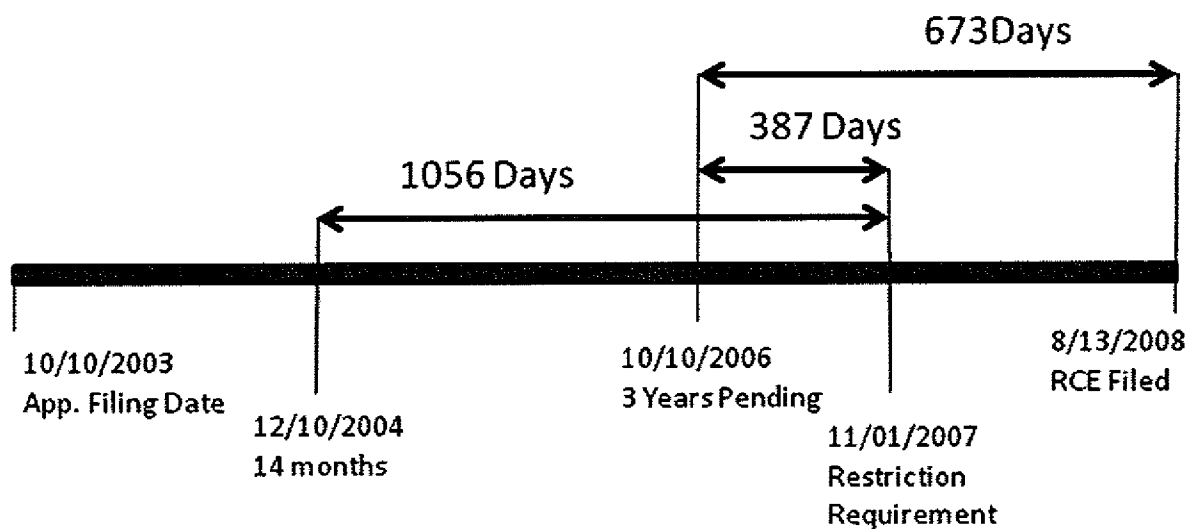
Pursuant to 35 U.S.C. § 154(b) and MPEP § 1.702-705, Applicant respectfully contends that the patent term adjustment for the subject application is 1342 days and not 853 days as asserted by the Office. The Office delayed taking certain actions within specified time frames under the Rules that resulted in patent term adjustment. Those delayed actions include not mailing “at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a)” and failure to “issue a patent within three years of the actual filing date of the application.” *See* MPEP § 1.702(a)(1) & (4). Applicant’s determination of 1342 days of patent term adjustment resulting from those delayed actions are explained below with reference to MPEP § 1.702-1.705.

The period of adjustment under § 1.702(a) is a sum of periods, including a time that starts “beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a)” and ends “on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.” *See* MPEP § 1.703(a)(1). Applicant’s filing date is October 10, 2003. The date fourteen months after the date on which the application was filed is December 10, 2004. A first office action was mailed November 1, 2007. The date of the first office action was therefore 1056 days after the fourteen month period following the filing date. In Applicant’s application, none of the periods in § 1.703(a)(2)-(6) appear to be applicable at this time. Therefore, the current standing sum of days of the period of adjustment under § 1.702(a) is 1056 days.

The period of adjustment under § 1.702(b) is a period marked by a starting date “beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a)” and ending “on the date a patent was issued” but not including, among other periods, “the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.” *See* MPEP § 1.703(b)(1). Applicant’s application was filed on October 10, 2003, and the date three years after the filing date is October 10, 2006. A request for continued examination was filed on August 13, 2008. The period of time between October 10, 2006 and August 13, 2008 is 673 days. In Applicant’s application, none of the periods in § 1.703(b)(2)-(4) appear to be applicable at this time. Therefore, the sum of days of the period of adjustment under § 1.702(b) is 673 days.

In Applicant’s application, none of the periods of adjustment under § 1.702(c)-(e) appear to be applicable at this time.

The MPEP states that “[t]he term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704.” MPEP § 1.703(f). There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in § 1.704, and therefore there are no reductions to the period of adjustment of the patent term pursuant to § 1.704. The periods of time associated with § 1.702(a) and § 1.702(b) overlap only in part. More specifically, they overlap for the period between October 10, 2006, and November 1, 2007, which is a period of 387 days. The number of days of patent term adjustment should therefore be calculated as 1056 days plus 673 days minus 387 days which is 1342 days. A graphical representation of the dates described is included below for clarity. This application is not subject to any terminal disclaimer. The fee set forth in § 1.18(e) is included with this paper.



This calculation of 1342 days is consistent with the January 7, 2010 decision in *Wyeth v. Kappos* by the United States Court of Appeals for the Federal Circuit. See *Wyeth v. Kappos*, No. 2009-1120, 2010 U.S. App. LEXIS 300 (Fed. Cir. Jan. 7, 2010). The *Wyeth* court held that “section 154(b)’s limitation provision makes it clear that no ‘overlap’ happens unless the violations occur at the same time. Each ‘period of delay’ has its own discrete time span whose boundaries are defined in section 154(b)(1). That is, each has a start and an end. Before the three-year mark, no ‘overlap’ can transpire between the A delay [due to failures of the PTO to meet deadlines specified in clauses (i)-(iv) of § 1.54(b)(1)(A)] and the B delay [due to failures of the PTO to issue a patent within 3 years after the actual filing date per 35

U.S.C. § 154(b)(1)(B)] because the B delay has yet to begin or take any effect. If an A delay occurs on one day and a B delay occurs on a different day, those two days do not ‘overlap’ under section 154(b)(2).” *Wyeth*, 2010 U.S. App. LEXIS 300, at *12. In this application, the A delay was 1056 days, the B delay was 673 days, and those periods overlapped by only 387 days. Therefore, the proper patent term adjustment is 1342 days (i.e., $PTA = 1056 \text{ days} + 673 \text{ days} - 387 \text{ days} = 1342 \text{ days}$).

Conclusion

In view of the foregoing, Applicant respectfully submits that the patent term adjustment should be 1342 days, and Applicant requests such correction.

The fees for this submission are being paid by credit card. However, the Commissioner is hereby authorized to charge any deficiency in required fees or credit any overpayment to Deposit Account No. 03-3483.

Respectfully submitted,

/court b. allen/

Courtenay B. Allen

Reg. No. 43,469

COX SMITH MATTHEWS INCORPORATED

112 East Pecan Street, Suite 1800

San Antonio, Texas 78205-1536

(210) 554-5389

(210) 226-8395 (FAX)

ATTORNEYS FOR APPLICANT

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